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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/754,958	01/05/01	AUER	M 4-30730B/D1

001095  
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PATENT AND TRADEMARK DEPT  
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HM12/1023

EXAMINER  
GARCIA, M

ART UNIT 1627

PAPER NUMBER  
DATE MAILED: 10/23/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. <b>09/754,958</b>	Applicant(s) <b>Auer et al</b>
Examiner <b>Maurie E. Garcia, Ph. D.</b>	Art Unit <b>1627</b>

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 10, 2001

2a)  This action is **FINAL**. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 3-5 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 3-5 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

### **DETAILED ACTION**

**Please note:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1627**. Also please note the change in examiner.

**Also Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The Response filed August 10, 2001 (Paper No. 4) is acknowledged. No claims were amended, added or cancelled. Therefore, claims 1-11 are pending.
  
2. Applicant's election with traverse of Group III (claims 3-5) in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
  
3. Claims 1, 2 and 6-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions. Election was made without traverse in Paper No. 4.

***Election/Restriction***

4. Upon review of the instant case by the new examiner, the application was deemed to contain claims directed to patentably distinct species of the claimed invention. Election is required as follows. Claim 3 is generic to all species.

5. This application contains claims directed to the following patentably distinct species of the claimed invention as set forth below. Election from the following species is required. Note: applicant must elect **one** species from **each** subgroup below.

**Subgroup 1: Species of A moiety (solid support)**

- A. Functionalized polystyrene based resins
- B. Polyacrylamide based polymers
- C. Polystyrene / polydimethylacrylamide composites
- D. PEGA resins
- E. Polystyrene-polyoxyethylene based supports
- F. Tentagel
- G. PEG-polystyrene graft polymeric supports
- H. Glass surfaces
- I. Functionalized surfaces
- J. Materials grafted with functionalized surfaces
- K. Polyethylenglycol

**Subgroup 2: Species of B moiety (linker)**

- A. Benzyl
- B. Benzhydryl
- C. Benzhydryliden
- D. Trityl
- E. Xanthenyl
- F. Benzoin
- G. Silicon
- H. Allyl

Note: A *specific* linker compound must be elected. All atoms and bonds of the compound must be shown.

Subgroup 3: Species of C moiety

A *specific* compound of formula (I) must be elected. All atoms and bonds of the compound must be shown.

Subgroup 4: Species of D and D' moiety

Note that an election for BOTH of D and D' must be made from the following:

- A. Bond
- B.  $\alpha, \omega$ -diamino-alkanes
- C. Diaminocyclohexyl
- D. Bis-(aminomethyl)-substituted phenyl
- E.  $\alpha$ -amino- $\omega$ -hydroxy-alkanes
- F. Alkylamines
- G. Cyclic alkylamines
- H. Cyclic alkyldiamines
- I. Amino acids

Note: If D and/or D' are not a bond, then a *specific* compound must be elected. All atoms and bonds of the compound must be shown.

Subgroup 5: Species of E moiety (molecule to be investigated)

- A. Low molecular weight compound
- B. Peptide/protein
- C. Carbohydrate
- D. Nucleic acid
- E. Lipid

Note: In addition to the general class of molecule set forth above, a *specific* molecule must also be elected. All atoms and bonds of the molecule must be shown. See paragraph 6 below.

6. Additionally, for purposes of search, applicant is required to elect a *single, specific* compound of Formula (III). To avoid confusion, a *specific* chemical structure must be elected that shows all of the A, B, C, D, D' and E moieties in their entirety, the linkage sites and linkages between them.

7. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Moreover, the above species can be separately classified. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.
8. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-

0065. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00 and alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.  
October 20, 2001



A handwritten signature in black ink, appearing to read "Maurie E. Garcia".

MAURIE E. GARCIA, Ph.D  
PATENT EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie E. Garcia, Ph.D.

ART UNIT: 1627

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

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